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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/389,386	09/03/99	IZQUIERDO	P. 225/48098

QM32/1023  
EVENSON MCKEOWN EDWARDS AND LENAHAH PLLC  
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WASHINGTON DC 20005

EXAMINER

NGUYEN, T

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 10/23/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/389,386

Applicant(s)

Izquierdo et al.

Examiner

Trinh Nguyen

Group Art Unit

3726

☒ Responsive to communication(s) filed on Sep 8, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) 5-9,12-14,17,21,23 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4,10,11,15,16,18,19,20,22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5 and 6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3726

## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election without traverse of claims 1-4, 10, 11, 15, 16, 18, 19, 20 and 22 is acknowledged. Moreover, claims 5-9, 12-14, 17, 21 and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

### *Drawings*

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: S, W, and 21 in Figure 3. Correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 10, 11, 15, 16, 18, 19, 20, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 15: the term "the material" lacks proper antecedent basis.

Art Unit: 3726

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 10, 11, 15, 16, 18, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Palazzolo et al. (US 5,691,004).

Palazzolo et al. teach a method for surface treatment of an interior of a hollow body such as an engine cylinder bore, wherein the method comprising the step of dry-cutting, i.e., honing, milling, drilling, brushing, knurling, and/or abrading, the interior of the hollow body (13) by using a tool (19, 17) to remove a surface material therein.

Regarding claim 4, note in lines 1-20 of col. 3, Palazzolo et al. disclose that the tool can be comprised of any hard material such as boron nitride, coated or uncoated metal, or even diamond.

Regarding claims 10 and 11, note in lines 19-23 of col. 3, Palazzolo et al.'s tool (19) is an indexing insert wherein the tool is fitted with a plurality of indexing inserts (17).

Regarding claims 16 and 17, note in the Abstract, Palazzolo et al. teach that after the honing/dry-cutting step the interior surface of the hollow body is thermally sprayed with a metallic bond coat.

Art Unit: 3726

Regarding claim 22, note in Figure 1, the surface profile of tool (19, 17) is an undefined surface profile.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzolo et al. (US 5,691,004).

With respect to claim 19, Palazzolo et al. disclose the claimed invention except for specifying that "the dry cutting is performed with at most 150 ml/h of lubricant". However, it is the examiner's position that such aforementioned limitation was a matter of design choice, wherein no significant problem is solved or unexpected result obtained, since it being assumed that the ordinary skill artisan would use a best known fabricating technique best suited for a particular application, in order to realize the benefits of obtaining a high quality level of surface treatment effectiveness.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form PTO-892 encloses herewith.

Art Unit: 3726

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Trinh Nguyen** whose telephone number is **(703) 306-9082**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

TTN

October 12, 2000

*J. C. A. R. b.*  
*Deu 3726*